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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL R. GAGNON

Appeal 2009-005082
Application 10/720,948
Technology Center 3700

Decided:¹ July 20, 2009

Before BRADLEY R. GARRIS, CATHERINE Q. TIMM, and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1-22. We have jurisdiction under 35 U.S.C. § 6.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

We AFFIRM-IN-PART.

Statement of the Case

Appellant claims a sports vision training device 10 comprising a piece of material having a thickness (e.g. one quarter inch per claim 20) sufficient to interfere with an individual's ability to look in a specific direction at a sporting object being controlled by the individual and the piece of material having an adhesive coating 22 for positioning the piece of material beneath an individual's eye (Fig. 1, claim 1). The upper surface of the material may be intermittently grooved to permit momentary glances at the sports object (Fig. 6, claim 6). The material also may have a narrow stem at the base of which is an adhesive for allowing momentary glances downwardly at the sports object being controlled by the user (Fig. 5, claim 19; *see also* claim 14). Appellant additionally claims a system for training an individual to look up and forwards while playing a sport without looking down at the object being controlled by the individual which comprises a pair of view restricting members each of which corresponds to the training device described above (claim 10). Finally, Appellant claims a method for training an individual playing a sport comprising the steps of providing a member of the type described earlier and positioning the member on a cheek under an eye of the individual in a position where the thickness of the member interferes with the individual's ability to look downwardly at a sports object being controlled by the individual and restricts the individual's field of vision to looking forward and up towards a field of play (claim 18).

Representative claims 1, 6, 18, and 19 read as follows:

1. A sports vision training device comprising:

a piece of material having a thickness sufficient to interfere with an individual's ability to look in a specific direction at a sporting object being controlled by the individual; and

 said piece of material having an adhesive coating or layer for positioning said piece of material; and

 said piece of material being positioned beneath an individual's eye without said piece of material covering any portion of said eye so that said piece of material interferes with said individual's ability to look at said sporting object while attempting to control said sporting object due to said thickness while said piece of material allows said individual to look forward and up without any vision obstruction.

6. A sports vision training device according to claim 1, wherein said piece of material has an upper surface and said upper surface is intermittently grooved to permit momentary glances at said sports object.

18. A method for training an individual playing a sport, said method comprising the steps of:

 providing at least one member having an upper edge, an adhesive coating or layer and a thickness sufficient to interfere with said individual's field of vision; and

 positioning said at least one member on at least one cheek under an eye of said individual in a position where said upper edge is beneath said eye and which does not cover any portion of said eye so that said thickness interferes with the individual's ability to look downwardly at a sports object being controlled by the individual and to restrict said individual's field of vision to looking forward and up towards a field of play and at least one person on said field of play.

19. A sports vision training device according to claim 1, wherein said piece of material has a narrow stem at the base of which is the adhesive.

The references set forth below are relied upon by the Examiner as evidence of unpatentability:

Micchia	4,719,909	Jan. 19, 1988
Morgan	4,951,658	Aug. 28, 1990
Arnold	6,320,094 B1	Nov. 20, 2001

The Examiner rejects claims 1, 2, 7-10, 15, and 20-22 under 35 U.S.C. § 102(b) as being anticipated by Arnold.²

The Examiner also rejects claims 3-6, 11-14, 16, 17, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Arnold in view of Morgan.

Finally, the Examiner rejects claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Micchia in view of Arnold.

The § 102 Rejection

Issue

Has Appellant shown error in the Examiner's finding that Arnold discloses eye patches which inherently possess the capability of being positioned beneath an individual's eye so as to interfere with the individual's ability to look at a sporting object being controlled by the individual as required in claims 1 and 10?

Findings of Fact

Arnold discloses eye patches which are adhesively applied to the eyes of a patient undergoing surgery and facial care procedures (col. 1, ll. 7-10, para. bridging cols. 1-2, Figs. 6-7). These eye patches comprise first and second sheet members 11, 12 each having preferably the same thickness ranging from 0.1 mm to 5 mm (col. 2, ll. 18-19, col. 3, ll. 39-45). Summing

² The final rejection of claim 18 as being anticipated by Arnold has been withdrawn by the Examiner (Ans. 10).

the individual member thicknesses yields eye patch thicknesses ranging from 0.2 mm to 10 mm which corresponds to 0.008 inches to 0.29 inches.

Because the members 11, 12 are adhered together with adhesive layer 13a (Fig. 3), the actual thicknesses of Arnold's eye patches will be greater than this summed range as expressly found by the Examiner (Ans. para. bridging 3-4). This finding by the Examiner regarding the thicknesses of Arnold's eye patches has not been disputed by Appellant.

Also undisputed is the Examiner's finding that Appellant discloses that thicknesses of one quarter inch or more are sufficient to perform the vision-interference functions required by claims 1 and 10 or the Examiner's concomitant finding that Arnold's eye patches may have the same thicknesses as the claim 1 vision training device or the claim 10 view restricting members (*id.*). Because the patch thicknesses disclosed by Arnold include those disclosed by Appellant, the Examiner finds that "it is reasonable to consider Arnold's eye patch as inherently capable of performing applicant's vision-interference functions recited in claims 1 and 10" (*id.*).

The Examiner additionally finds that "Arnold's patch reasonably appears to be capable of being applied, via its adhesive, on a cheek under an eye of the user" and that "[t]he patch, so positioned, would inherently interfere with the user's vision as claimed since the patch has the same thickness and would be at the same location as applicant's claimed device" (Ans. 4, first full para.).

Principles of Law

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997).

A patent applicant is free to recite features of an apparatus either structurally or functionally. Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. Specifically,

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Id. at 1478 quoting *In re Swinehart*, 439 F.2d 210, 213 (CCPA 1971).

Analysis

Regarding claims 1 and 10, Appellant argues that, “even if the eye patch [of Arnold] were positioned in a location beneath the eye, there is no evidence that the thickness of Arnold’s material would interfere with the individual’s ability to look at a sporting object” (Reply Br. 3).

This argument is factually erroneous and therefore unconvincing. The Examiner has explicitly proffered evidence in the form of undisputed findings that the eye patch thicknesses disclosed by Arnold include the thicknesses which are disclosed by Appellant as capable of performing the interference function recited in claims 1 and 10.

Appellant also argues that some of the thicknesses in Arnold’s disclosed range may not be the same as Appellant’s disclosed thicknesses (Reply Br. para. bridging 3-4). According to Appellant, the Examiner’s

inherency position is improper under these circumstances since “[m]ere probabilities or possibilities are insufficient to establish an inherency argument” (*id.*).

On the record before us, there is no question that a number of the thickness embodiments disclosed by Arnold are the same as the thickness embodiments disclosed by Appellant. This fact provides adequate reason to believe that Arnold’s eye patches inherently possess the capability of performing the interference function recited in claims 1 and 10. Therefore, it is proper to require the Appellant to prove that the eye patches of Arnold do not inherently possess this capability. Appellant does not satisfy this burden simply by pointing out that some of the thicknesses disclosed by Arnold fall outside the thickness range disclosed by Appellant. This is because Appellant’s point does not establish or even address whether Arnold’s eye patches do or do not actually possess the capability in question. For all we know based on the record of this appeal, all the thickness embodiments disclosed by Arnold, including those outside Appellant’s disclosed range, inherently possess the capability of performing the interference function recited in claims 1 and 10.

We find no merit in Appellant’s additional argument that “Arnold only discloses a single eye patch” (Reply Br. 4) and therefore fails to satisfy the claim 10 requirement for a pair of view restricting members (*id.*; *see also* App. Br. 10). Contrary to Appellant’s belief, Arnold discloses plural eye patches (Fig. 6) whereby a patch is applied to each eye of a patient undergoing surgery or facial care procedures (para. bridging cols. 1-2; *see also* col. 1, ll. 13-32).

For the reasons set forth above and in the Answer, Appellant has failed to show error in the Examiner's rejection of claims 1 and 10.

Appellant's other arguments concerning the Examiner's § 102 rejection also fail to show error. This is because the arguments do not specifically address the Examiner's rationale in making this rejection. For example, Appellant's arguments regarding claims 7 and 8 (App. Br. 15-16) do not rebut or even acknowledge the Examiner's position that these claims lack patentable weight because they recite printed matter not functionally related to the substrate (Ans. para. bridging 5-6). Similarly, Appellant's claim 15 argument (App. Br. 16, Reply Br. 5) fails to address the Examiner's inherency rationale concerning this claim (Ans. 5, 11). Because these other arguments fail to address the rationale of the Examiner's rejection, they necessarily fail to show error in the rationale or the rejection premised thereon.

Conclusions of Law

Appellant has not shown error in the Examiner's finding that Arnold discloses eye patches which inherently possess the capability of being positioned beneath an individual's eye so as to interfere with the individual's ability to look at a sporting object being controlled by the individual as required in claims 1 and 10.

For this reason, we sustain the Examiner's § 102 rejection of claims 1, 2, 7-10, 15, and 20-22 as being anticipated by Arnold.

The § 103 Rejection of claims 6, 14, and 19 over Arnold in view of Morgan

Issue

Has Appellant shown error in the Examiner's finding that the eye patches of Arnold have intermittent grooves in the upper surface as required by claims 6 and 14 and that the eye patches of Arnold have a narrow stem on the base of which is adhesive as required by claims 14 and 19?

Findings of Fact

Regarding claims 6 and 14, the Examiner finds that Arnold shows a patch having an upper surface "wherein the upper surface is intermittently grooved (best seen in figures 3 and 5)" (Ans. 8).

We find that Figures 3 and 5 of Arnold show the cross-sectional view of an eye patch which includes an indented contour around the outer perimeter of the patch (*see also* Figs. 1, 4). To the extent this contour may be considered a groove, the contour or groove is continuous (e.g., *see* Figs. 1, 4) rather than intermittent.

Regarding claims 14 and 19, the Examiner finds that Arnold shows an eye patch which "includes a narrow stem at the base of the adhesive (best seen in figures 3 and 5)" (Ans. 8, 9).

We find that Figures 3 and 5 of Arnold do not show "a narrow stem at the base of which is the adhesive" as recited in claims 14 and 19.

Principles of Law

Rejections on obviousness grounds cannot be sustained by mere conclusory statements. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) cited with approval in *KSR Int'l Co. v. Teleflex*, 550 U.S. 398, 417-18 (2007).

Analysis

Appellant argues that the eye patches of Arnold do not contain the intermittent groove or narrow stem features required by claims 6, 14, and 19 (Reply Br. 6-7). We agree.

As stated above, Figures 1 and 3-5 of Arnold show a continuous contour extending around the periphery of the depicted eye patch. While this contour might be considered a groove, it certainly is not an intermittent one as required by claims 6 and 14. Instead, the contour or groove is continuous. As for the narrow stem limitation of claims 14 and 19, we perceive no such feature in Arnold's Figures 3 and 5. The Examiner's findings to the contrary are erroneous and seemingly conjectural.

Conclusions of Law

Appellant has shown error in the Examiner's finding that the eye patches of Arnold have intermittent grooves in the upper surface as required by claims 6 and 14 and that the eye patches of Arnold have a narrow stem on the base of which is adhesive as required by claims 14 and 19.

As a result, we cannot sustain the § 103 rejection of claims 6, 14, and 19 as being unpatentable over Arnold in view of Morgan.

The § 103 Rejection of Claims 3-5, 11-13, 16, and 17

over Arnold in view of Morgan

Issue

Has Appellant shown error in the Examiner's conclusion that it would have been obvious to form Arnold's eye patch with open-cell foam and with hydrocolloidal adhesive material in view of Morgan?

Findings of Fact

Appellant does not dispute the Examiner's findings that Arnold teaches making eye patches of a biocompatible foamed plastic material having an adhesive but is silent as to the foam being open-cell as required by claims 3, 11, and 16 and is silent as to the adhesive being hydrocolloidal and/or moisture absorbing as required by claims 4, 5, 13, and 17 (Ans. 7-8).

Appellant also does not dispute the Examiner's finding that Morgan teaches making an eye patch of open-cell foam material having a moisture absorbing hydrocolloidal adhesive whereby moisture from the user's skin passes through the adhesive and the open-cell foam material for evaporation therefrom (*id.*).

Principles of Law

The question to be asked in considering the obviousness of a claim to a combination of prior art elements is whether the improvement is more than the predictable use of the prior art elements according to their established functions. *KSR*, 550 U.S. at 417.

Analysis

According to the Examiner,

it would have been *prima facie* obvious at the time the invention was made, to a person of ordinary skill in the art, to have combined Morgan's open-cell foam material with Arnold's biocompatible foam eye patch in view of Morgan's express teachings as to the enhanced comfort and breathability of a patch made of open-cell foam

(Ans. 7).

In opposing this obviousness conclusion, Appellant argues that an artisan would not form Arnold's eye patch from an open-cell foam material because the open-cells would not provide the desired level of protection during procedures involving abrasion systems, chemicals, air jets, and liquids (App. Br. 17, second full para.).

This argument is unpersuasive for two reasons. First, Appellant has proffered no evidence to support the proposition that the open-cell foam material of Morgan would not perform effectively during procedures involving abrasion systems, chemicals, air jets, and liquids. Second, Arnold discloses that eye patches are used in other procedures in order to protect the eyes of a patient from damage, for example, by scalpels (col. 1, ll. 21-26). On this record, Appellant does not contend that an open-cell foam material would fail to provide the desired level of protection for eye patches used in such other procedures. Moreover, it is significant that Appellant does not disagree with the Examiner's determination that Morgan's open-cell foam material would provide Arnold's eye patches with the advantages of enhanced comfort and breathability.

The Examiner also concludes that

it would have been *prima facie* obvious at the time the invention was made, to a person of ordinary skill in the art, to have used Morgan's hydrocolloidal adhesive material as the adhesive for Arnold's adhesively attached eye patch in order to increase the comfort of the user and permit the patch to adhere better to the individual's skin as taught by Morgan

(Ans. para. bridging 7-8).

Appellant argues that this obviousness conclusion is erroneous because “[a]llowing moisture to be transferred to the piece of material

covering the eye would increase the weight of the material until such time as the moisture evaporates and make the patient's eye uncomfortable" (App. Br. para. bridging 17-18).

Again, Appellant has provided no evidence in support of the argument that using Morgan's adhesive material for the adhesive required by Arnold would make the patient's eye uncomfortable. Indeed, this argument is contrary to the Examiner's undisputed findings regarding the comfort advantages of Morgan's adhesive material (Ans. para. bridging 7-8).

In summary, the record before us reflects that the Examiner's proposed combination of Arnold and Morgan would result in a combination of prior art elements predictably used in accordance with their established functions.

Conclusions of Law

Appellant has not shown error in the Examiner's conclusion that it would have been obvious to form Arnold's eye patch with open-cell foam and with hydrocolloidal adhesive material in view of Morgan.

Therefore, we sustain the Examiner's § 103 rejection of claims 3-5, 11-13, 16, and 17 as being unpatentable over Arnold in view of Morgan.

The § 103 Rejection of Claim 18 over Micchia in view of Arnold

Issue

Has Appellant shown error in the Examiner's conclusion that

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have made Micchia['s] patch device with an alternative thickness [i.e., the thickness required method claim 18] as disclosed by

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Arnold in order to aid in reducing glare and absorbing moisture from the user's face

(Ans. 9) ?

Findings of Fact

The Examiner finds that Micchia discloses a method wherein a patch device is positioned under the eye of a user in order to absorb light (Ans. 9).

The Examiner acknowledges that Micchia does not disclose a particular thickness for the patch device but finds that Arnold teaches an eye patch having thicknesses which include those disclosed by Appellants as sufficient to perform the interference function recited in claim 18 (*id.*).

Principles of Law

There must be some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d at 988 quoted with approval in *KSR*, 550 U.S. at 417-18.

Analysis

Appellant argues that the Examiner's rejection of claim 18 is improper because

[n]either [of the Micchia or Arnold] references teaches the step of "positioning said at least one member on at least one cheek under an eye of said individual in a position where said upper edge is beneath the eye and which does not cover any portion of said eye so that said thickness interferes with the individual's ability to look downwardly at a sports object being controlled by the individual and to restrict said individual's field of vision to looking forward and up towards a field of play and at least one person on said field of play."

(App. Br. para. bridging 19-20).

This argument is factually correct and persuasive.

The Examiner does not disagree with the Appellant's correct observation that neither Micchia nor Arnold teaches the claim 18 step of positioning a member under an eye of an individual so that the member thickness interferes with the individual's ability to look downwardly at a sports object being controlled by the individual. Nevertheless, the Examiner concludes that it would have been obvious to have made Micchia's patch device with a thickness (i.e., sufficient to perform the interference function of the claim 18 positioning step) "as disclosed by Arnold in order to aid in reducing glare and absorbing moisture from the user's face" (Ans. 9). Significantly, we find no teaching or suggestion in Arnold, and the Examiner points to none, that the thicknesses of Arnold's eye patch would "aid in reducing glare and absorbing moisture from the user's face" (*id.*).

This circumstance reveals that the Examiner's obviousness conclusion is not supported by articulated reasoning with a rational underpinning.

Conclusions of Law

Appellant has shown error in the Examiner's conclusion that [i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have made Micchia['s] patch device with an alternative thickness [i.e., the thickness required method claim 18] as disclosed by Arnold in order to aid in reducing glare and absorbing moisture from the user's face (Ans. 9).

It follows that we cannot sustain the Examiner's § 103 rejection of claim 18 as being unpatentable over Micchia in view of Arnold.

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Summary

We have sustained the § 102 rejection of claims 1, 2, 7-10, 15, and 20-22 as being anticipated by Arnold as well as the § 103 rejection of claims 3-5, 11-13, 16, and 17 as being unpatentable over Arnold in view of Morgan. We have not sustained the § 103 rejections of claims 6, 14, and 19 over Arnold in view of Morgan or of claim 18 over Micchia in view of Arnold.

Order

The decision of the Examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

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